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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/348,529 07/07/99 SLATER

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EXAMINER

FELTEN, D

ART UNIT

PAPER NUMBER

2164

DATE MAILED:

09/13/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/348,529

Applicant(s)

Slater et al

Examiner

Daniel Felten

Art Unit

2164



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jul 7, 1999
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirements.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Jul 7, 1999 is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 4 & 6 20) ☐ Other: _____

DETAILED ACTION

Drawings

1. New formal drawings are required in this application because of the problems indicated on the Notice of Draftperson's Patent Drawing Review filed July 7, 1999. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the Patent and Trademark Office no longer prepares new drawings.

Claim Objections

2. Claims 8 and 22 are objected to because of the following informalities:

Re claim 8: Delete, "MICR", and insert, --Magnetic Image Character Recognition (MICR)--

Re claim 22: Delete, "presentment will be by paper, ECP, image, ACH..." , and insert, --the

presentment will be by paper, Extended Capabilities Part (ECP), image, Automatic Clearing

House (ACH)...-- Appropriate correction is required.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The applicant discloses the limitation of a first location being an automatic teller machine (as in claim 11), owned and/or operated by someone other than the owner of the second location.

The applicant further discloses the limitation of a first location being a bank (as in claim 13), retail business location (as in claim 14), a business (as in claim 15), and being located outside the United States (as in claim 16).

The aforementioned claim limitation are considered non-functional descriptive material which have no bearing on the utility of the invention, and therefore are not patentably distinct.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 22 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 22, the phrase "or other method" renders the claim(s) indefinite because the claim(s) include(s) elements and/or methods not actually disclosed (those encompassed by "or other method"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

7. Claims 1-3, 7, 9, 10, 12, 13, 18, 20, and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by "NCR's ATM Captures Images at the point of Deposit", *Financial Services Report*, Jan 20, 1993, Vol. 10, No. 2. (Hereinafter referred to as NCR)

As per claim 1:

NCR discloses a method for image based transactions, comprising:

1 receiving at a first location at least one of an instrument and cash having a front face and
2 a back face;

3 scanning the front face and the back face of said at least one of an instrument and cash to
4 create a deposited instrument or an electronic validation of deposited cash;

5 transmitting the scanned deposited instrument or cash from the first location to a second
6 location; and

7 processing a transaction with the scanned deposited instrument or electronic
8 validation of deposited cash (see NCR entire article).

9
10 **As in claim 2:**

11 the deposited at least one of an instrument and cash is a check ; and wherein said processing
12 comprises crediting a deposit in the amount of the check to a customer's account (see NCR entire
13 article).

14
15 **As in claim 3:**

16 further comprising displaying an image of the scanned at least one of an instrument and cash on
17 a terminal display at the first location to provide confirmation to a customer that the deposit has
18 been accepted (see NCR entire article).

19
20 **As in claim 7:**

1 the first location is an automatic teller machine, owned and operated by a bank for its customers,
2 having a scanner and display, and the method further comprising storing the scanned at least one
3 of an instrument and cash in the automatic teller machine (see NCR entire article).

4
5 **As in claim 9:**

6 further comprising separately entering the amount on the at least an instrument and cash which
7 has been scanned, comparing the amount entered with the amount scanned, and if the scanned
8 amount matches the entered amount, conducting the processing of the transaction (see NCR
9 entire article).

10
11 **As in claim 10:**

12 further comprising composing, encrypting and digitally signing the instrument before the
13 transmission to the second location for processing (see NCR entire article).

14
15 **As in claim 12:**

16 wherein said at least one of an instrument and cash is a check (see NCR entire article).

17
18 **As in claim 13:**

19 wherein said first location is a branch of a bank (see NCR entire article).

1 **As in claim 18:**

2 further comprising endorsing the instrument (see NCR entire article).

4 **As in claim 20:**

5 further comprising comparing the information on the instrument to information contained in a
6 file of indicators of potential loss (see NCR entire article).

8 **As in claim 21:**

9 further comprising maintaining a file of payor bank preferences for how the payor bank will
10 receive presentment, and processing the transaction in accordance with the preferences (see
11 "...selects type of transaction", within the NCR article).

15 ***Claim Rejections - 35 USC § 103***

16 8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all
17 obviousness rejections set forth in this Office action:

18 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
19 section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
20 such that the subject matter as a whole would have been obvious at the time the invention was made to a person
21 having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the
22 manner in which the invention was made.

1 9. Claims 4-6, 8, 17, 19 and 23 are rejected under 35 U.S.C. 103(a) as being
2 unpatentable over "NCR's ATM Captures Images at the point of Deposit", *Financial Services*
3 *Report*, Jan 20, 1993, Vol. 10, No. 2. (Hereinafter referred to as NCR) in view of Cahill et al
4 ('Cahill', US 5,940,844). The teachings of NCR have been discussed above.

5
6 **Regarding claims 4-6:**

7 NCR fails to teach, as in claim 4, recreating the scanned deposited instrument onto
8 paper; the recreating of the instrument onto paper further comprises cutting the paper to the size
9 of a check, as in claim 5; and wherein said recreating of the instrument onto paper is done at the
10 second location, as in claim 6.

11 Cahill discloses the aforementioned limitations (see Cahill, col. 32, ll. 5-39). It would
12 have been obvious for an artisan of ordinary skill at the time of the invention to employ a
13 means to recreate the scanned deposited instrument onto paper because an artisan would
14 recognize that a customer may desire a 'backup' hard copy for personal records. Thus such a
15 modification would be an obvious expedient well within the ordinary skill in the art.

16
17 **As in claim 8:**

18 NCR in view of Cahill discloses further comprising recreating the scanned deposited instrument
19 into a paper image which is MICR encoded (see NCR entire article).

1 **Regarding claim 17:**

2 NCR fails to disclose voiding the instrument at the first location by printing on the instrument or
3 destroying the instrument.

4 Cahill discloses a means of destroying the instrument by deletion. It would have been
5 obvious for an artisan of ordinary skill at the time of the invention of NCR to employ the
6 means of deleting the instrument, as found in Cahill because the ability to delete a check would
7 provide the user the option to cancel undesirable transactions. An artisan would find such a
8 feature useful to users in order for them to easily correct potential transactional errors . Thus,
9 to provide a means for voiding a check would have been an obvious.

10
11 **Regarding claim 19:**

12 NCR fails to disclose transmitting the image to another location to display to an operator for
13 resolution if the amounts entered and scanned differ. Cahill discloses the aforementioned
14 limitation (see Cahill, col. 34, ll. 66 to col. 35, ll. 56) . It would have been obvious for an
15 artisan of ordinary skill at the time of the invention to integrate the aforementioned limitation
16 found in Cahill into the invention of NCR because an artisan would have realized that it is
17 notoriously old and well known within the art to transmit/receive data from an ATM over an
18 network. Thus such a modification would be an extension of the teachings of Cahill inasmuch
19 as an artisan of ordinary skill at the time of the invention would have obviously sought the use

1 of a network in order to electronically transfer funds from one terminal (ATM) to another
2 terminal (host).

3
4 **As in claim 23:**

5 further comprising maintaining a file of routing preferences, and processing the transaction in
6 accordance with the preferences .

7
8
9 10. Claims 24 rejected under 35 U.S.C. 103(a) as being unpatentable over Cahill et al
10 ('Cahill', US 5,940,844) in view of NCR article.

11
12 **Regarding claim 24:**

13 Cahill discloses all the limitations within the claim for conducting image based transactions,
14 comprising: a scanner located at a first location and configured for scanning the front face
15 and the back face of at least one of an instrument and cash, having a front face and a back
16 face, for creating a instrument or cash (see Cahill Abstract; and col. 5, ll. 57-61);
17 means for transmitting the scanned instrument or cash from the first location to a second
18 location; means for receiving the transmitted scanned instrument or cash, said means for
19 receiving being located at the second location; and means for processing a transaction with the
20 scanned instrument or cash (see Cahill col. 3, ll.8-15; and col. 4, ll. 4+).

1 Cahill fails to disclose that the instrument or cash is deposited. NCR discloses that the
2 instrument or cash is deposited. Since Cahill provides a means of scanning the checks and other
3 documents into his system, it would have been obvious for an artisan of ordinary skill at the time
4 of the invention of to provide a means to deposit checks, as found in NCR, into the invention of
5 Cahill because an artisan at the time of the invention would have viewed such a feature as an art
6 recognized equivalent inasmuch as both systems capture material checks (and other documents)
7 into electronic images to be manipulated by the system. Furthermore, the ability to make
8 deposits is a conventional transaction that is well known and widely used within the art, and
9 would have provided the Cahill invention with a conventional means to input checks and
10 documents through the system. Thus such a substitution of would have been obvious to one of
11 ordinary skill in the art.

12
13 **As in claim 25:**

14 comprising means for processing a transaction with the same information as if the original was
15 available (see NCR entire article).

16
17 **As in claim 26:**

18 The system of claim 25 wherein said scanner is adapted for scanning the front face and back face
19 of a check; and wherein said means for processing is for crediting a deposit in the amount of a
20 scanned check to a customer's account (see NCR entire article).

1 **As in claim 27:**

2 The system of claim 26 further comprising a display located at the first location for displaying an
3 image of a scanned at least one of an instrument and cash, for providing visual confirmation to a
4 customer that the deposit has been accepted (see NCR entire article).

5
6 **As in claim 28:**

7 comprising a printer adapted for recreating an instrument as an image on paper, and composited
8 with machine-readable regenerated MICR
9 -- encoding of the original instrument's MICR code line data (see NCR entire article).

10
11 **As in claim 29:**

12 wherein said printer is located at the second location (see NCR entire article)

13
14 **As in claim 30:**

15 Cahill in view of NCR discloses an automatic teller machine having said scanner thereon at the
16 first location, and having a secured container region therein for storing scanned instruments or
17 cash in the automatic teller machine (see NCR entire article).

1 **As in claim 31:**

2 Cahill in view of NCR discloses wherein the printer is capable of recreating the scanned image
3 into a paper image which is MICR encoded, and composited with machine readable regenerated
4 MICR encoding of the original instrument's MICR code line data (see NCR entire article)

5
6 **As in claim 32:**

7 Cahill in view of NCR further comprising: means for separately entering the amount on an at
8 least one of an instrument and cash which has been scanned; and means for comparing the
9 account entered with the amount scanned for allowing transmission to conduct processing of the
10 transaction (see NCR entire article).

11
12 **As in claim 33:**

13 Cahill in view of NCR further comprising means for compressing, encrypting and digitally
14 signing the scanned at least one of an instrument and cash before transmission to the second
15 location for processing (see NCR entire article).

16
17 **As in claim 34:**

18 Cahill in view of NCR the scanner is adapted for scanning the front face and the back face of a
19 check (see NCR entire article).

1 **As in claim 35:**

2 Cahill in view of NCR the second location has means for sending the information it receives to a
3 third location for processing within or for another bank (see Cahill col. 1, ll. 9-18).

4
5 **As in claim 36:**

6 Cahill in view of NCR the second location has means for sending the information it receives to
7 the Federal Reserve Bank or one of its offices or a clearinghouse as a third location, and the third
8 location has means for creating the images on paper and MICR encodes them for entry into the
9 check processing system or sending the information to a bank for payment (see Cahill col. 1, ll.
10 9-18).

11
12 **As in claim 37:**

13 The system of claim 24 further comprising means at the second for sending the information it
14 receives directly to the payor bank or its processing agent or correspondent for payment (see
15 NCR entire article).

16
17 **As in claim 38:**

18 comprising a device having said scanner thereon at the first location, and having a secured
19 container region therein for storing scanned instruments or cash at a branch of a bank (see NCR
20 entire article).

1 As in claim 39:

2 comprising a device having said scanner thereon at the first location, and having a secured
3 container region therein for storing scanned instruments or cash at a business (see NCR entire
4 article).

5
6 **Conclusion**

7
8 11. Any inquiry concerning this communication or earlier communications from the examiner
9 should be directed to **Daniel S. Felten** whose telephone number is (703) 305-0724. The
10 examiner can normally be reached between the hours of 7:00AM to 5:30PM Monday-Thursday.
11 Any inquiry of a general nature relating to the status of this application or its proceedings should
12 be directed to the Customer Service Office (703) 306-5631, or the examiner's supervisor
13 **Vincent Millin** whose telephone number is (703) 308-1065.

14
15 12. Response to this action should be mailed to:

16
17 Commissioner of Patents and Trademarks

18 Washington, D.C. 20231

19
20 for formal communications intended for entry, or (703) 305-0040, for informal or draft
21 communications, please label "Proposed" or "Draft".

22 Communications via Internet e-mail regarding this application, other than those under 35
23 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be

1 addressed to [daniel.felten@uspto.gov].
2
3

4 All Internet e-mail communications will be made of record in the application file. PTO
5 employees do not engage in Internet communications where there exists a possibility that
6 sensitive information could be identified or exchanged unless the record includes a properly
7 signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly
8 set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and
9 Trademark on February 25, 1997 at 1 195 OG 89.
10
11

12 

13 Daniel S. Felten
14 August 29, 2001


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